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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/780,206

02/09/2001

Michael Fritz

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20306

7590

01/28/2004

MCDONNELL BOEHNEN HULBERT & BERGHOFF  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/780,206

**Applicant(s)**

FRITZ ET AL.

**Examiner**

Suryaprabha Chunduru

**Art Unit**

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-41 and 68-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-41 and 68-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Acknowledgement is made for the request to establish continued prosecution application (RCE) filed on December 22, 2003. The request for RCE is accepted and is established with the status of the application as follows:

- a. the filling date of this RCE is established as February 9, 2001;
  - b. Claims 36-41,68 and new claims 69-76 are pending. Claims 1-35, 42-67 are cancelled.
2. Applicants' response to the earlier office action filed on 12/22/2003 is considered and has been entered.

***Priority***

3. This application has a filling date as February 9, 2001 and claims priority to a foreign application Germany 100 06 214.8 filed on February 11, 2000. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

***Response to Arguments***

4. Applicants' response to the office action is fully considered and found persuasive.
5. With reference to the rejection under 35 USC 102(e), Applicants' amendment and arguments are fully considered and the rejections are withdrawn herein in view of the amendment and new grounds of rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36-41, 68-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Lange (USPN. 6,071,395).

Lange teach an apparatus of claim 36, and 70-72, for detecting nucleic acids in a sample comprising

(a) a binding space for purifying the nucleic acids by immobilizing (absorption medium) the nucleic acids and separating impurities (see column 5, lines 33-67, column 9, lines 25-50);

(b) an amplification space (removal compartment) for amplifying the nucleic acids, wherein a part of removal compartment of amplification space is identical to a part of the binding space (absorption medium), i.e., at least part of removal compartment is situated in reaction chamber which has absorption medium (see column 5, lines 46-67, column 6, 10-21, column 9, lines 50-59);

(c ) a detection space (chemiluminescence detector space) for detecting the nucleic acids (see column 6, lines 21-24, column 9, lines 60-66, column 10, lines 1-15).

With regard to claim 37, 73, Lange also teaches that the apparatus comprises reagents for purifying, amplifying and detecting nucleic acids (see column 9, lines 28-66, column 10, lines 1-15);

With regard to claim 38, Lange teaches that the detection space comprises a part of the amplification space and the binding space (see column 9, lines 35-66, wherein removal compartment is a part of absorption medium and detection space, see Fig. 13);

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With regard to claims 39-40, 74-75, Lange also teaches that the binding space and amplification space comprises a capillary space (electrophoretic matrix) (see column 5, lines 46-67, Fig. 13), which is surrounded by a heatable metal layer (electrodes) (see column 4, lines 65-67, lines 52-67, column 9, lines 49-60);

With regard to claim 41, 76, Lange teaches that the capillary space (electrophoretic buffer tank) is a conductive plastic (polystyrene) (see column 5, lines 1-2);

With regard to claim 68, Lange teaches that the apparatus comprises capillary reaction vessel surrounded by a single heatable metal layer, wherein the layer is coated on the capillary reaction vessel (see Fig. 13, wherein reaction compartment 17, removal compartment 50 and detection photoamplifier 314 are surrounded by a single heatable metal layer 220);

With regard to claim 69, Lange teaches that the apparatus comprises a sample transport mechanism (through electrophoresis device) for transporting the sample and reagents through the binding space, amplification space and the detection space (see column 5, lines 46-67, column 6, lines 10-24, column 9, lines 28-66, column 10, lines 1-15);

### ***Conclusion***

No claims are allowable.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Gary Benzion can be reached on 571-272-0782 . The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Suryapragha Chunduru  
January 21, 2004

Jehanne Sitton  
Primary Examiner  
  
1/21/04